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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,655	05/30/2000	Emmanuel Custodero	33218-PCT-USA-A (070338.0)	2078

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EXAMINER

BOSS, WENDY L

ART UNIT	PAPER NUMBER
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1775

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DATE MAILED: 05/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/583,655

Applicant(s)

CUSTODERO ET AL.

Examiner

Wendy Boss

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-14 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6 and 15-21, drawn to a process of coating carbon black, classified in class 427, subclass 212.
 - II. Claims 7-14 and 22, drawn to a modified carbon black, classified in class 428, subclass 408.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the modified carbon black could be made by treating carbon black with an alkoxy or organoalkoxy compound at a temperature in a range of about 25-800° C in an inert gaseous atmosphere for a period of about 10 to about 150 minutes (see column 3, lines 48-54 of U.S. Patent No. 6,090,880).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Rochelle Seide on May 22, 2002 a provisional election was made with traverse to prosecute the invention of Group II, claims 7-14 and 22.

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Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-6 and 15-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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7. Claims 7-9 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,090,880 (Zimmer et al.).

8. Zimmer discloses a modified carbon black coated with an adhering layer of aluminum hydroxide (see column 1, line 65 through column 2, line 1). Zimmer further discloses that the amount of surface aluminum is between 0.5 and 10% by mass (see column 3, lines 8-12), which encompasses the range recited in claim 9.

The reference does not necessarily disclose that the modified carbon black is obtained by the process of one of claims 1-6; however, patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113).

9. Claims 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 3502494 (Sugiura et al.).

Sugiura discloses a modified carbon black with an adhering layer of aluminum oxide wherein the amount of surface aluminum is greater than 0.25% by mass (see English Abstract; and Table 1). The reference does not necessarily disclose that the modified carbon black is obtained by the process of one of claims 1-6; however, patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 10-14 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,090,880 (Zimmer et al.) as evidenced by U.S. Patent No. 4,590,039 (Cheng).

12. Zimmer discloses a modified carbon black characterized by: being coated at least in part by a layer of aluminum hydroxide (see column 1, line 65 through column 2, line 1); and having a specific BET surface area of between 20 and 400 m²/g (see column 3, lines 22-30). Zimmer further discloses that the carbon black has an amount of surface aluminum from between 0.5 and 10% by mass (see column 3, lines 8-12), which encompasses the range recited in claims 13 and 14. The Zimmer reference also discloses a process for reinforcing a diene rubber composition which can be used for the manufacture of tires comprising incorporating the above carbon black into the composition before introducing a vulcanization system. It is also disclosed by Zimmer that the carbon black may be N110 type. Attention is directed to column 4, lines 16-17 of Cheng which teaches that N110 carbon black has an average particle size ranging from 20-30 nm, which is within the applicants claimed particle size range.

Zimmer does not disclose the ultrasound disagglomeration rate of the carbon black; however, it is within the level of one having ordinary skill in the art to determine such a property.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wendy Boss whose telephone number is 703-306-5922. The examiner can normally be reached on M-Th 8:30a-6:00p; 2nd F 8:30a-5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 703-308-3822.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Wendy Boss
May 22, 2002


DEBORAH JONES
SUPERVISORY PATENT EXAMINER